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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,987	06/26/2003	Marc Christian Davis	DWP-P-1	5142
49578	7590	12/03/2008		
SIMMONS PATENTS P.O. BOX 1560 LENOIR, NC 28645				
EXAMINER				
GRAHAM, MARK S				
ART UNIT		PAPER NUMBER		
3711				
MAIL DATE		DELIVERY MODE		
12/03/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/606,987

**Applicant(s)**

DAVIS ET AL.

**Examiner**

Mark S. Graham

**Art Unit**

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-8,10-17 and 54-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,10-17 and 54-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claim 13, the originally filed disclosure does not disclose a bat wherein the inner third portion of the bat is the densest section of the bat made from a single material while the outer first and second portions of the bat are of different densities and are formed of multiple materials.

With regard to claims 14 and 15, there is no original disclosure of lamina in a given portion which vary progressively in density as claimed.

With regard to claim 16, there is no disclosure of a third portion having twice the density as the material in the handle as claimed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender in view of Smith. Note Bender at Col. 5, lines 16-19 specifically and the entire

disclosure generally. Bender discloses the claimed device with the exception of the use of different materials to obtain the different densities. However, such is a known technique in the art as taught by Smith. It would have been obvious to one of ordinary skill in the art to have used different materials in forming Bender's bat as well if it was desired to obtain particular densities in the different layers offered by different materials.

Particularly concerning claims 54-58 Bender does not disclose whether the material used for the lamina in each of his portions is the same or of different materials. However, as noted above it is known in the art to use different materials in laminated bats when looking to obtain a particular density of material. It would have been obvious to one of ordinary skill in the art to have done the same in obtaining the individual lamina in each of Bender's different portions as well depending on what wood was available and met the necessary requirements as to density.

Claims 1-3, 6, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender in view of Smith and Cook. Note Bender at Col. 5, lines 16-19 specifically and the entire disclosure generally. Bender discloses the claimed device with the exception of the use of different first and second materials to obtain the different densities. However, such is a known technique in the art as taught by Smith. It would have been obvious to one of ordinary skill in the art to have used different materials in forming Bender's bat as well if it was desired to obtain particular densities in the different layers offered by different materials.

Bender in view of Smith obviates the claimed device for the reasons set forth above with the exception of the limitations pertaining to providing the different portions

adjacent to one another along the length of the bat. However, as disclosed by Cook it is known in the art to vary the density of the bat along the longitudinal axis of the bat by creating separate sections adjacent to one another. It would have been obvious to one of ordinary skill in the art to have done the same with Bender's laminated sections to tailor the bat to a particular batter's needs. As stated by the Board of Patent Appeals and Interferences in the 2/28/08 decision each of the Bender, Smith, and Cook references are "directed to laminated bats which have increased performance or durability. Bender teaches increasing the durability, i.e., strength, of the bat by employing an inner laminated layer and outer laminated layers having a different density from the inner layer (Finding of Facts 1-4). Smith teaches using different types of wood for different portions/sections of the bat (Finding of Fact 9). Finally, Cook teaches using different laminated sections along the longitudinal axis of the bat (Finding of Fact 12). Therefore, it would have been within the skill of one of ordinary skill in the art to use different wood types as taught by Smith to alter the densities of the inner and outer layers of lamina not only along the vertical axis of the bat as taught by Bender, but also along the longitudinal axis as taught by Cook. Appellants have not provided any evidence that such a modification is outside the capabilities of one of ordinary skill in the art or that it produces an unexpected result."

With regard to the newly added limitation to claim 1, Bender's bat will inherently have a center of mass located wherever the artisan constructing the bat desires it. It would have been obvious to one of ordinary skill in the art to have located it in any

portion of the bat which a particular batter desired depending on their individual preferences.

Concerning claim 11, Cook teaches the use of maple.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above and further in view of Winterowd. Bender in view of Smith and Cook obviates the claimed device with the exception of the type of bonding agent used. However, as disclosed by Winterowd bonding agents such as that claimed are known in the woodworking art for bonding laminates. It would have been obvious to one of ordinary skill in the art to have used such as Bender's bonding agent to provide a secure bond.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above and further in view of Burns. Bender in view of Smith and Cook obviates the claimed device with the exception of the sealant/protectant. However, as disclosed by Burns sealant/protectants such as that claimed are known for use on bats. It would have been obvious to one of ordinary skill in the art to have used such on Bender's bat to protect it.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable the art as applied to claim 1 above and further in view of You. Bender in view of Smith and Cook obviates the claimed device with the exception of the use of composites to form laminations. Bender uses wood for his laminations. However, as disclosed by You it is known in the art to use composites for such laminations as well. It would have been

obvious to one of ordinary skill in the art to have used the same on Bender's bat to add strength to it.

Applicant's arguments filed 8/25/08 have been fully considered but they are not persuasive.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 571-272-4410.

MSG  
12/2/08

/Mark S. Graham/  
Primary Examiner, Art Unit 3711